

REMARKS

The objection to Claim 3 has been addressed.

The rejection of Claims 3, 11 and 14 under 35 U.S.C. §112, ¶2 is traversed, and reconsideration is respectfully requested in light of the foregoing non-limiting amendments. Applicants submit, however, that the rejection is based upon minor objections, not matters affecting the particularity and distinctness of the claims to one of ordinary skill in the art in light of the detailed disclosure in this application.

The rejection of Claims 3 and 14 as being unpatentable over Takamoto et al., of Claims 2, 9, 10 and 11 as being unpatentable over Takamoto in view of Siepker, of Claims 5, 6, and 13 as being unpatentable over Takamoto et al. in view of Hotta, and of Claim 8 as being unpatentable over Takamoto et al. in view of Hotta and Siepker, all under 35 U.S.C. §103(a), are traversed. Reconsideration is requested in light of the following additional comments and the comments found in the papers filed May 1, 2003 and July 28, 2003.

The Office Action maintains that the Takamoto et al. patent teaches a positional control based upon vehicle position, namely the position encoder signal Y which is introduced into the control "law" [?] in Fig. 4. Irrespective of the accuracy of that assertion, however, the Examiner candidly acknowledges that the Takamoto et al. fails to teach a fundamental aspect of the present invention, namely using a minimum torque for maintaining the vehicle at a stopped

position. The Examiner does not assert any other *prior art* reference to teach this concept.

The Patent and Trademark Office cannot, as a matter of law, establish a *prima facie* case of obviousness in modifying a reference with substantial record evidence for doing so. The motivation provided in the Office is one that is not found in the Takamoto et al. patent. Instead, it arises from impermissible hindsight made apparent by applicants' contribution.

It has long been the law that rejections based on obviousness must rest on a factual basis. In re Warner, 379 F.2d. 1011, 154 USPQ 173 (CCPA 1967). The mere fact that the *prior art* could arguably be modified in the manner asserted by the Examiner does not make the modification obvious unless the *prior art* suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, M.H, 23 USPQ 2d 1780, 1783-84, M.14 (Fed. Cir. 1992). Despite the extended prosecution of this case and the Examiner's reliance upon secondary references, no factual showing exists in the record to support the proposition that the *prior art* possessed the motivation to modify a known controller to maintain minimum torque. The Examiner's assertion to the contrary begs the question of what the *prior art* taught.

Inasmuch as the Takamoto et al. patent is the lynchpin of the several rejections. All the claimed subject matter is not properly rejected under 35 U.S.C. §103(a). Thus, early and favorable action is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #05620844743C1).

Respectfully submitted,

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